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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,548	10/31/2003	Michael F. Hoey	M190.133.102	3065

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/699,548	HOEY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Michael Pefley	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 6-48 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 6-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

Applicant's amendments and arguments, filed September 6, 2005, have been fully considered by the examiner. In particular, it is noted that applicant has not updated the specification as requested by the examiner in the previous Office action. The objection to the specification is maintained in the instant Office action. The following is a complete response to the September 6, 2005 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Specification***

The disclosure is objected to because of the following informalities: the first sentence of the specification must be updated to provide the most current status (i.e. US Patent Number) of the related applications.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

Claims 6-16, 19-32, 35-45 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al (5,383,874).

Jackson et al disclose a surgical system comprising a surgical instrument (22) having an ablation element (16), a memory chip on the instrument and a processor for receiving the information stored on the chip (see columns 7 and 8). The processor is adapted to limit the number of times the device may be used (Abstract and col. 8, lines 59+) and is adapted to relate the delivery of appropriate energy based on the stored parameter (columns 7 and 8). The catheter may include a temperature sensor and store information regarding the temperature sensor (col. 7, lines 20-25). The method of

operating such a device is fully disclosed by Jackson et al. The examiner maintains the memory chip of the Jackson et al device is inherently "adapted" to provide predetermined time limit information. That is, while Jackson et al do not specifically disclose that time limit information is used as an operating parameter stored on the memory chip, it is inherently capable of storing and providing this information. It is noted that applicant's claims do not positively recite time limit information stored on the memory chip. Rather, applicant has amended the claims to recite a memory (or a means) which is "adapted" to provide time limit information. The phrase "adapted to" is interpreted to be analogous to "capable of" and is not deemed to be a positive recitation of any specific structure, but rather a suggestion of a possible use of the structure (i.e. memory chip).

***Claim Rejections - 35 USC § 103***

Claims 17, 18, 33, 34, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al (5,383,874) in view of the teaching of Nardella (5,334,193).

The Jackson et al system has been previously addressed. While Jackson et al disclose that various catheters may be connected to the system, there is no specific mention of providing a source of fluid through the catheter and/or storing information regarding fluid flow.

The examiner maintains that one of ordinary skill in the art would recognize that any well-known catheter may be used with the Jackson et al system, including a fluid delivery catheter such as taught by Nardella. The Nardella catheter is very much like

the ablative catheter disclosed by Jackson et al, and specifically includes means to provide a conductive fluid through the catheter as well as means to control the flow of the fluid. To have stored information regarding the fluid-flow parameters of such a catheter, or any other relevant information, would have been an obvious consideration for one of ordinary skill in the art.

To have provided the Jackson et al system with a fluid-delivery ablation catheter to enhance treatment of tissue in the presence of fluid would have been an obvious modification for one of ordinary skill in the art, particularly since Nardella teach of the advantages of providing conductive fluid to tissue during RF ablation procedures.

#### ***Response to Arguments***

Applicant's arguments filed September 6, 2005 have been fully considered but they are not persuasive.

Applicant asserts that the claims have been amended to recite a memory chip or means for providing or delivering a predetermined time limit for an operating parameter. As asserted in the body of the rejection, it is the examiner's position that the language "adapted to" merely suggests a capability of the memory, and is not an explicit limitation of the functionality of the memory. The examiner maintains that the Jackson et al memory chip is inherently capable of storing any relevant information, including information regarding time, and is therefore anticipatory of the amended claim language. With regard to claim 20, it is noted that the language recites "an identifying means coupled to the surgical instrument and the RF generator to provide at least one predetermined time limit for an identifying characteristic". There is no specific "means

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for" language, and the claim is not deemed to be in conforming "means plus function" format. As with claim 6, the language "to provide" is deemed to be a simple statement of the capability of the identifying means. As asserted previously, the Jackson et al identifying means, which includes a memory chip and a processor just as disclosed in the instant application, is deemed inherently capable of providing the same information if so programmed. Again, the claims do not positively recite that the memory chip is programmed with any specific information.

Regarding claims 10, 25 and 38, the applicant asserts that Jackson et al fail limit the total amount of time the ablating energy is delivered, and that Jackson et al instead limit the number of times the device is used. First, the examiner maintains that limiting the number of times the device is used is inherently limiting the total time ablation energy is being delivered. Second, as addressed previously, these claims recite that the processor is "adapted to" limit the total time. The examiner again asserts that this language is essentially equivalent to "capable of", and the Jackson et al processor is inherently capable of (i.e. "adapted to") being programmed to limit the time the ablating energy is delivered.

Finally, with regard to the Nardella teaching, the examiner maintains that one of ordinary skill in the art would recognize the relevant teaching in Nardella that it is advantageous to deliver a cooling fluid through an ablation catheter and would further recognize that fluid flow would be a parameter that could obviously be identified on an ablation catheter. Whether the specific parameter is a specific amount of fluid flow, or a variable relation between the fluid flow and measured temperature and/or impedance

would be an obvious consideration for one of ordinary skill in the art. The examiner maintains that one of ordinary skill in the art, after considering the teaching of Nardella, would recognize the importance of identifying catheter cooling characteristics and could then obviously devise a means to store the necessary information on a memory chip in a system such as disclosed by Jackson et al.

***Conclusion***

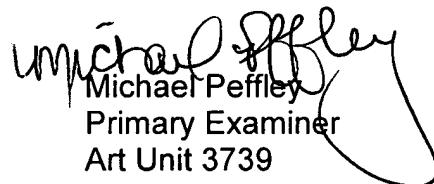
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
November 23, 2005